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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,750	07/27/2001	Kwong Heng Kwok	PA000011	9079

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EXAMINER

OLSON, JASON C

ART UNIT PAPER NUMBER

2651

DATE MAILED: 08/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/916,750

Applicant(s)

KWOK, KWONG HENG

Examiner

Jason C Olson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-7 and 9-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-16 is/are allowed.
- 6) ☒ Claim(s) 2-7, 9, 17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 17 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which has not been described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 17 and 18, on page 5 of Amendment and Response filed on 6/01/04, were added by the Applicant to define a unidirectional tape motion but the instantaneous specification fails to disclose the method of drawing the tape by the capstan in a single direction and moving the tape drawn by the capstan only in first direction, so therefore is considered new matter by the Examiner.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 2-7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Masuda et al. (5448427).

Regarding claim 2, Masuda et al. teaches controlling a capstan in a tape recorder/reproducer by rotating a capstan in a first direction (illustrated in figure 6, items 39, 40, 17, and 18, which depicts the capstan controlling the tape movement, and Figure 4, which depicts the tape being moved by the capstan from say, the start of (n+1)th Group to the start of the (n-2)th Group); driving a capstan (see col. 4, ln. 40-41) in a backward direction (or opposite direction or second direction) for a period of time (see col. 3, ln. 51-55; col. 4, ln. 50-55, and illustrated in figure 6, items 39, 40, 17, and 18. The Examiner notes that "backward" is a relative term for direction and takes the position that when the capstan rotates in a counter-clockwise direction it is moving in a backward direction. Furthermore, as it is depicted in figure 4, when the capstan moves in a backward direction, the tape moves in a second direction from say, the start of (n-2)th Group to the start of the (n+2)th Group.); driving the capstan in a forward direction (or first direction) for a period of time (see col. 3, ln. 55-61; col. 4, ln. 50-55, and illustrated in figure 6, items 39, 40, 17, and 18. The Examiner notes that "forward" is a relative term for direction and takes the position that when the capstan rotates in a clockwise direction it is moving in a forward direction. Furthermore, as it is depicted in figure 4, when the capstan moves in a forward direction, the tape moves in a first direction from say, the start of (n+2)th Group to the start of the (n-1)th Group.); the capstan current is nullified (see col. 6, ln. 12-19 and as depicted in figure 4 at STOP and in figure 9 which illustrates the that the capstan motor is stopped during normal STOP mode.).

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Regarding claims 3-7, ranges of time periods are not considered patentable subject matter because it is not inventive to discover the optimum or workable ranges by routine experimentation (see *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235(CCPA 1955)).

Regarding claim 9, a capstan motor is driven in a backward direction for a period of time; the capstan motor is driven in a forward direction for a period of time (see col. 4, ln. 52-61, furthermore, it is known to an artisan in the art that the direction or sign of the drive current determines the directional spin of the motor.).

Allowable Subject Matter

Claim 10 is allowed. The prior art fails to teach alone or in combination controlling a capstan following the successive steps of rotating the capstan in a first direction; when a first predetermined period of time has elapsed after a control pulse is detected by the control pulse sensor, applying a torque to the capstan in a second direction opposite the first direction for a second predetermined period of time; applying a torque to the capstan in the first direction for a third predetermined period of time; nullifying the motor current.

Claims 11-16 are allowed. The prior art fails to teach alone or in combination rotating a capstan in a first direction, applying a torque to the capstan in a second direction for a first predetermined period of time, applying a torque to the capstan in the first direction for a second predetermined period of time, wherein the control current is strictly positive during the first and second period of time, the control rotation direction is set backward during the first period of time and the control rotation direction is set forward during the second period of time.

Response to Arguments

Applicant's arguments filed on 06/01/04 have been fully considered but they are not persuasive. The Applicant argues that Masuda et al. teaches bi-directional tape motion, so therefore does not disclose the capstan motor control as recited in the instantaneous invention. The Examiner agrees that Masuda et al. teaches bi-directional tape motion, but further dissents on the point that it does not teach the Applicant's invention. With regard to claim 2, there is insufficient wording to limit the capstan control to a non bi-directional motion and thus does not distinguish it from the teachings of Masuda et al. Therefore, claims 2-7 and 9 stand rejected as being anticipated by Masuda et al.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason C Olson whose telephone number is 703.305.8325. The examiner can normally be reached on Monday thru Thursday 7:30-5:30; alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (703)308-4825. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JCO

August 9, 2004



SINH TRAN
PRIMARY EXAMINER